

REMARKS

It is respectfully submitted that the Final Action should not have been final because it presents new grounds of rejection not necessitated by amendment, as will be explained below. Therefore, it is respectfully submitted that this amendment should be entered.

This amendment makes changes to Claim 1 to address concerns raised by the Examiner. It makes multiple relatively minor amendment to many of the claims, including rejected independent claims 1 and 28, that are not related to any rejection, for the purpose of correcting errors and improving readability. And it adds new claims 39-41, which are roughly similar to former Claim 1..

After this amendment the pending claims include all of the previously pending claims, i.e., claims 1-9, 14-26, 28, and 34-38, plus new claims 39-41.

THE FINAL ACTION'S REJECTION OF CLAIM 28 IS BASED ON NEW  
GROUNDS NOT NECESSITATED BY AMENDMENT -- THUS, FINAL  
REJECTION IS PREMATURE

The Final Action has rejected Claim 28 based on new grounds. The top of page 7 of the Final Action based its rejection of Claim 28 on the allegation that Col. 8, Lines

58-67, of Smith discloses the following recited feature of the claim:

"providing a user interface for enabling a user to select, as a groups, the users who have selected to associate a given set of one or more of said values with a given node, and to select to address said message to said group...." (Strikethrough added to reflect current amendment.)

The first office action, dated March 16, 2004, (the "First Action") did not allege that Smith or any other reference ever disclosed the above quoted feature of Claim 28. Thus, the Final Action's argument that the above quoted feature was disclosed by Smith is clearly a new grounds of rejection.

Under MPEP 706.07(a) a final rejection is improper "where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during [a specific] period." Thus, unless the above described new grounds for rejection is either necessitated by amendment or based on information in an IDS, the current final rejection is improper.

The new grounds of rejection in question are clearly not based on information submitted in an IDS, since it is based on the Smith reference, a reference that was not listed in this applicant's IDS and was cited in the previous office action.

The new grounds for rejection were not necessitated by an amendment because the only amendments made to claim 28 were minor and formal, and, thus, did not create the need for the new grounds of rejection.

The only amendments that had been made to claim 28 before the Final Action were (1) the deletion of hyphens at the start of each paragraph, as requested by the Examiner, and (2) correcting an obvious grammatical mistake by inserting "said" before the last occurrence of the word "message" in the claim.

The deletion of hyphens can't be considered to have necessitated the new grounds of rejection because it made no change to the meaning of the claim.

Similarly the insertion of "said" before "message" does not change the meaning of claim 28 and, thus, could not necessitate the new grounds of rejection. This is because the insertion of "said" was required to fix an obvious grammatical mistake. Grammar dictates that an article be inserted before the claim's last occurrence of "message", but it wasn't in the claim's original language. Grammar requires the inserted article to either be a definite article, such as "the" or "said", or an indefinite article, such as "a." But since there is another occurrence of the word "message" at the end of the prior paragraph, and since the prior paragraph would have little relevance unless the two occurrences of "message" were

related, the natural interpretation of the claim's original language indicates a definite article, either "said" or "the" be inserted. Thus, the addition of the word "said" merely makes grammatical the clear intent of the claim, and, thus, make no substantive change to claim 28 which could have necessitated the new grounds of rejection.

But even if, for sake of argument, one hypothesizes it was not clear whether a definite or indefinite article should precede the last occurrence of "message" in Claim 28, the insertion of the definite article "said" instead of a possible indefinite one did not necessitate the new ground of rejection. This is because a new grounds of amendment would have been required independently of whether a dependent, independent, or no article at all had been inserted before the last occurrence "message" in claim 28. This is because the First Action totally failed to provide any evidence of any prior art that disclosed any type of message in the context recited in the above quoted feature from Claim 28, regardless of whether one interprets the last occurrence of "message" a being properly preceded by an indefinite or definite article. In other words, the new grounds of rejection were necessitated by the fact that no proper grounds of rejection had addressed anything to do with the sending of any type of message in the prior action.

Thus, it is clear that under MPEP 706.07(a) the current final rejection is premature. Therefore, it is

respectfully submitted that the final rejection be withdrawn and that this amendment be entered.

THE ONLY CLAIMS REJECTED IN THE FINAL ACTION ARE CLAIM 1,  
CLAIMS THAT DEPEND FROM CLAIM 1, AND CLAIM 28

Paragraphs 5, 7, and 10 of the Final Action describe the only claim rejections contained in that action. The only claims these paragraphs reject are Claim 1, the claims that depend from Claim 1 (i.e., Claims 2-4 and 9), and Claim 28.

We will discuss claim 28 first since we have been discussing it immediately above.

THE FINAL ACTION'S NEW GROUNDS OF REJECTION FOR CLAIM 28  
ARE WITHOUT MERRIT

As quoted above, Claim 28 recites a feature that allows a user to address a message to a group of users selected based on values such users have associated with a given node. The Final Action's rejection of claim 28 on page 7 depends on the allegation that this feature is disclosed in Col. 8, Lines 58-67, of Smith. The complete text of these cited lines from Smith read as follows:

"Graphical user interface controls 176 are rendered on a display screen and allow a user to select modifications of the visualization format and the

visualization style, as described below in greater detail. Generally, visualization format selections are used to control database filter 174, and visualization style selections are used to control the appearance of the visualization. A rendering engine 178 renders a network graphical visualization according to results obtained by database filter 174 and visualization style selections made with user interface controls 176"

In the few seconds it takes to read this text it can be seen that it makes no disclosure of anything concerning the sending of messages, nevertheless the sending messages to a group selected in the particular manner recited in claim 28. Therefore, the Final Action's rejection of claim 28 based on such text is clearly unfounded.

Therefore, it is respectfully submitted that claim 28 is patentable and that it should be allowed.

CLAIM 1 HAS BEEN AMENDED TO ADDRESS EXAMINER'S REJECTION OF CLAIMS 1-4 AND 9

Paragraph 5 of the Final Action rejected Claims 1-4 and 9 under §112, ¶2, because the limitation "the relative" had insufficient antecedent basis. In response claim 1 has been amended by removing the words "the relative." It is hoped this will also remove this §112 rejection.

Paragraph 7 of the Final Action rejected independent claim 1 as having been made obvious by Smith and Heckerman. In the last amendment the applicant argued that Claim 1 is

distinguished from the combined teaching of these two references because it recites a user interface that:

"allows a user to 'explicitly order the relative ordinal ranking with each of a set of said nodes.'"

The Final Action's rejection of Claim 1-4 and 9 appears to rest on a belief that the above quoted word "explicitly", added in the first amendment, is not a technical term and that its meaning is not sufficiently clear to properly distinguish over the cited prior art.

Despite the fact that a good argument can be made that "explicit" is sufficiently clear to distinguish Claim 1 from the cited prior art, the Examiner's objections have persuaded the applicant that it would be preferable to use claim language that more clearly avoided such objections. Therefore the applicant has amended Claim 1 to replace "explicitly order" with a much more clear distinction over the prior art, i.e., to give an ordinal rank to each of a plurality of said nodes

"by dragging a visual representation of one or more of said plurality of nodes to a desired position relative to a visual representation of others of said plurality of nodes in a list displayed under said parent node, so as to indicate the ranking of said plurality of nodes under said parent node by their relative order in said list."

There is nothing in Smith or Heckerman which is at all similar to what is recited in this amended language.

Certainly neither of them recites the use of dragging to rank nodes.

This new language is clearly supported in FIG. 7 and the text that refers to it in the original specification from the first full paragraph on page 17 thru the first full paragraph on Page 18.

With this new language, it is respectfully submitted that Claim 1, and claims 2-4 and 9 which depend from it are clearly distinguished over the prior art, and it is respectfully submitted that they be allowed.

NEW CLAIMS 39-41

New claims 39-41 has been added. These are somewhat similar to former claim 1, except that like the amended version of claim 1, their language provides a more concrete description of how a user associates a rank with individual nodes, so as to more clearly distinguish over the prior art.

The specification supports the language of these new claims in FIGS. 7-9, and in the text of the original specification which extents from the first full paragraph on page 17 to the end of the second to the last paragraph on page 19.



PROPER ACKNOWLEDGEMENT OF PREVIOUSLY ALLOWED CLAIMS 37 AND  
38 IS REQUESTED

Claims 37 and 38 are not listed as pending in Item 5 of the Final Action's Office Action Summary, nor are they mentioned in its portion dealing with "Allowable Subject Matter" (in paragraph 8) and "Reasons for Indicating Allowable Subject Matter" (in paragraph 9).

This appears to be an oversight, since claims 37 and 38 both were allowed in the first office action, since they are mentioned in paragraphs 1 and 2 of the Final Action as still pending, and since there is no discussion of why they have omitted from the portions of the Final Action were they should have been mentioned.

Therefore it is respectfully requested that previously allowed Claims 37 and 38 be listed as pending and allowed.

OTHER MATTERS

As stated above a series of minor amendment have been made to the claims that are un-related to any rejection for the purpose of improving the grammar, style, and language and of the claims.

Paragraph 6 of the Final Action states that the application currently names joint inventors in its discussion of obligations under 37 CFR 1.56. It should be noted that the current application has only one inventor,

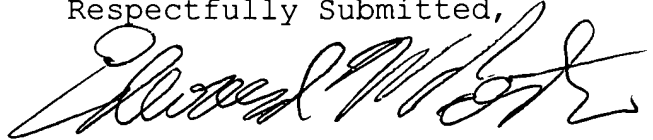
Edward W. Porter, as indicated in this application's filing receipt.

This amendment adds three new claims, and one new independent claim. This causes the total number of independent claims to be 14, one more than the 13 with which this application was originally filed, so an additional independent claim fee of \$100.00 is due. The amendment causes the total number of overall claims to be less than 38, the number of overall claims with which this application was filed. Thus no additional fee appears to be owing for the overall number of claims. As a result, a fee of \$100 is enclosed as part of the \$325.00 check that is filed with this amendment.

You are hereby authorized to bill any additional amounts which may be owing for this extension of time or for any matters relating to the attached response to the Office Action to the Porter & Associates deposit account numbered 502110.

If the Examiner has any questions or problems concerning this amendment, please call or write to the undersigned at the address or phone number indicated below.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Edward W. Porter", written in a cursive style.

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